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U.S.S.N. 09/961,049

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No:	09/961,049
Examiner:	Eng, George
Art Group:	2643
Reference No.:	EN11333
Appn. Filed:	September 24, 2004
Applicants:	Burrus, Philip
Title:	Cable or Module Identification Apparatus and Method

December 17, 2004

Assistant Commissioner for Patents
P.O. Box 1450, Alexandria, Virginia

Sir:

This appeal brief is being filed from the notice of appeal transmitted by facsimile on December 17, 2004. This appeal brief is being filed in triplicate, in accordance with the requirements of former 37 C.F.R §1.192. The Commissioner is hereby authorized to charge any necessary fees, including fees for extensions of time, to Deposit Account Number 50-0757.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office, with via facsimile to 703-872-9306 on DEC 17, 2004.

Printed Name: Philip H. Burrus, IV

Signed Name: _____

REAL PARTY IN INTEREST:

The real party in interest is Motorola, Inc., 100% interest assignee of record, whose mailing address is 1303 E. Algonquin Road, Schaumburg, Illinois.

RELATED APPEALS/INTERFERENCES:

This is the only pending appeal of this application. There are no pending interferences to the best knowledge of the Applicant.

STATUS OF CLAIMS:

Claims 1, 3-8 and 11-12 are pending in this application. Per the most recent Office Action (OA) mailed December 9, 2004, all of these claims are in condition for allowance except for a rejection under the judicially created doctrine of obviousness-type double patenting over commonly assigned US Pat. No. 6,509,659.

STATUS OF AMENDMENTS:

The most recent amendment was filed August 24, 2004. The most recent OA was mailed in response to this amendment.

SUMMARY OF INVENTION:

This invention is a universal power supply system. It has a universal power supply capable of sourcing various levels of voltage and current. The universal power supply has a universal connector, to which a cable is connected. The cable has a universal connector at one end, and a device specific connector at the other. The cable includes a capacitor having a value that is specific to the electronic device that couples to the device specific connector. The universal power supply applies a step response to the capacitor, and measures the exponential decay across the capacitor, thereby identifying the electronic device. The universal power supply then charges the device according to this identification.

ISSUES:

Whether an obviousness-type, non-statutory, judicially created double patenting rejection is proper for claims 1, 3-8 and 11-12 of the present application over claims 1-8 of US Pat. No. 6,509,659.

GROUPING OF CLAIMS:

Claims 3-8 depend from claim 1, which is independent. Claims 11 and 12 are also independent. Since the issue is a non-statutory, obviousness-type double patenting rejection, Applicant suggests that the amended claim 1 is the most representative claim for comparing the present application to the '659 patent.

ARGUMENT:

The most recent OA rejects claims 1, 3-8 and 11-12 under the judicially created doctrine of obviousness-type double patenting "so as to prevent the unjustified or improper timewise extension of the 'right to exclude' granted by a patent and to prevent possible harassment by multiple assignees." Specifically, the OA states that the otherwise allowable claims are rejected under this doctrine over commonly assigned US Pat. No. 6,509,659. The OA states that the claims are not identical, but the claimed limitations, including a universal base and interface device, are transparently found in the '659 patent.

Applicant notes that the present application is commonly assigned with the '659 patent, and was at the time the invention was made. Thus, a terminal disclaimer could in fact be filed under 37 CFR 3.73(b).

However, in this case, the present application is the senior application, in that it was filed on September 24, 2001. The '659 patent was not filed until October 24, 2001. As such, Applicant can not extend the time of the '659 patent with the present application. Further Applicant respectfully submits that the OA has not made a case for obviousness-type double patenting in that the OA fails to set forth a two-way obviousness case for the present application and the '659 patent. Applicant therefore traverses this rejection.

Applicant notes that according to MPEP §804, when the patent used as the basis for a non-statutory, judicially created double patenting rejection is the latter filed application, as is the case here, a two-way obviousness test is triggered. This test is triggered where the Applicant can show that the two inventions could not be filed in a single application, and where the delay is administrative. Under the two-way obviousness test, the Graham factors of obviousness must be applied to both the patent in light of the pending application and vice versa. "An obvious-type double patenting rejection is appropriate *only where each analysis compels a conclusion* that the invention defined in the claims in issue *is an obvious variation of the invention* defined in a *claim in the other application/patent*. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made..." *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). Emphasis added.

Here, Applicant respectfully submits that the claimed subject matter could not have been filed in a single application, and that the delay associated with the present application was administrative. Applicant further submits that the application at issue is not obvious over the patent.

Inventions could not have been filed in a single application

Applicant begins by respectfully submitting that the two applications could not have been filed in the same application because the invention of the '629 patent was conceived at a different time that the present application, by a different inventor. Further, the '659 patent deals with a cable having multiple ground pins, which are not suggested in the present application. Similarly, the present application teaches identification of an electronic device by applying a step response to a capacitor embedded in a cable, which is not suggested by the '659 patent. As different apparatuses are taught, Applicant respectfully submits that a single application would not have been possible.

Delay was administrative

Regarding the delay, Applicant respectfully submits that the delay in prosecuting the present application was administrative. Applicant notes that this is by no means a complaint, as Applicant is all too aware of the hard working, overburdened Examiners in the patent office. However, as a point of record, Applicant notes that a first office action in the present application was mailed nearly 3 years after filing. In the '659 patent, by

contrast, an office action was mailed less than 12 months after filing. Applicant respectfully submits that this was due in no fault of Applicant, and thus the delay was administrative. As MPEP §804 states, "Where, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection *is improper, in the absence of a two-way obviousness determination*, because the applicant does not have complete control over the rate of progress of a patent application through the Office." *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Emphasis added.

Present Application not obvious in view of patent

Applicant respectfully submits that the present application recites, e.g. in claim 1, element b, a capacitor that is used for identification, wherein the capacitor has a value that corresponds to an electrical device. Applicant respectfully submits that such a capacitor with a predetermined value is not taught by the '659 patent.

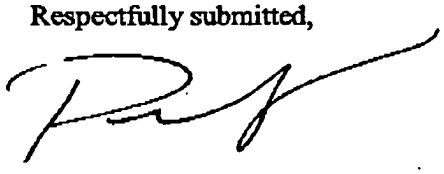
In the most recent OA, there is no suggestion of a two-way obviousness case between the present application and the '659 patent. The OA merely states that Applicant's argument is not persuasive because there is a possibility of "...possible harassment by multiple assignees."

Applicant respectfully submits that regardless of whether this is the case, MPEP §804 clearly sets forth a two-way obviousness test that must be met by the Patent Office for an obviousness-type double patenting rejection to be proper. Applicant respectfully submits that such a test has not been met, and therefore the rejection is improper. Applicant respectfully requests reconsideration of the rejection in light of MPEP §804 and these comments.

CONCLUSION

For the above reasons, Applicants believe the specification and claims are in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is in condition for allowance, for which they respectfully submit.

Respectfully submitted,



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